

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-43 are pending in this application. Claims 1-22 and 27-35 have been withdrawn from consideration. Claim 24 has been rewritten in independent form and Claims 23, 25, and 26 have been amended to better reflect accepted U.S. claim practice and to highlight that recording is automatically determined. In addition new Claims 36-39 have been added to present Claims 23-26 in "means plus function" format and new Claims 40-43 have been added to present Claims 23-26 as corresponding method claims. These amendments and additions have been made without the introduction of any new matter.

The outstanding Office Action presents a rejection of Claims 23, 25, and 26 under 35 U.S.C. §103(a) as being unpatentable over Dunton et al. (U.S. Pat. No. 6,304,284, Dunton) in view of Official Notice taken by the Examiner.

Initially, Applicants acknowledge with appreciation the indication that Claim 24 is only objected to as depending on a rejected claim and would be allowable if rewritten in independent form to include all of the limitations of base Claim 23, there being no intervening claims. As Claim 24 has been so amended, it is believed that allowance of Claim 24 is now in order, as is the allowance of new means plus function Claim 39 and method Claim 43 that correspond thereto.

In addition, Applicants acknowledge with appreciation the face-to-face discussion held between Applicants' representative, Examiner Gary Vieaux, and SPE Wendy Garber on April 25, 2005.

During this discussion, Applicants' representative pointed out that independent Claim 23 was directed to an image input apparatus with a first image pickup unit that will optically scan a subject to acquire plural partial images of the subject by moving in a plane that is

parallel to a plane of the subject. It was also pointed out that this movement is performed in the parallel plane without touching the subject and that this image input apparatus also has a second image pickup unit that will continuously pick up the image being scanned. It was emphasized that an overlapping amount calculating unit was further required to calculate an amount of overlap between the partial images picked up by the first image pickup unit based at least upon the image picked up by the second image pickup unit. Finally, it was noted that this image input apparatus further includes an image recording determination unit that will determine whether or not a current partial image being scanned by the first image pickup unit is to be recorded based upon at least the amount of overlap calculated by the overlapping amount calculating unit.

The paragraph bridging pages 3 and 4 of the outstanding Action was then noted by Applicants' representative to refer to the Claim 23 requirement for an overlapping amount calculating unit that will calculate an amount of overlap between the partial images picked up by the first image pickup unit in the abstract and not as fully set forth by Claim 23. In this regard, Applicants' representative noted that Claim 23 further requires that the calculation of the amount of overlap between the partial images picked up by the first image pickup unit must be "based upon the image picked up by said second image pickup unit."

Applicants' representative noted that the referenced portions of Dunton (col. 5, lines 2-6 and col. 8, lines 25-32) do not appear to teach "calculating" the amount of overlap between the partial images picked up by the first image pickup unit or that such a calculation should be "based upon the image picked up" by any pickup unit. Instead of making any calculation, the teaching of col.5, lines 2-6, simply suggests that there has to be "a sufficient amount of subject matter overlap 150." Further, Applicants' representative noted that the Dunton teaching at col. 8, lines 25-32, involves no indication of a calculation of an amount of overlap between partial images being picked up by any image pickup unit as it simply

suggests prompting the user to record partial image based upon the movement of the image pickup directly detected by tracking movement of a selected point in the camera's field of view from one edge thereof to another.

Moreover, Applicants' representative noted that even if these movement tracking teachings of Dunton could be somehow interpreted as suggesting this tracking involves some undisclosed calculation, the result still contains no suggestion or teaching of the Claim 23 image recording determination unit that will "determine whether or not a current partial image is to be recorded based upon the amount of overlap calculated by the overlapping amount calculating unit." Thus, Applicants' representative noted that the Dunton suggestion at col. 8, lines 25-27, is that the user is prompted to maintain needed image overlap and col. 8, lines 31-33, indicates it is the user who responds to this prompting to perform actual image recording, not a "recording determination unit."

These points raised by Applicants' representative notwithstanding, the Examiners urged that Dunton taught such units in terms of calculating overlap relative to at least step 520 in Figure 5 and the corresponding text in the Dunton specification. In this regard, while the Examiners appeared to acknowledge that Dunton employed visual prompts, their position was that the relationship of these visual prompts to the field of view would involve calculations and that the final determination that the area at the edge of the field of view provided sufficient overlap was, in fact, a determination whether or not a current partial image was to be recorded based upon the amount of overlap calculated by the processing that was determining the overlapping amount. Accordingly, the Examiners indicated that they did not find the arguments as to no actual calculations being taught and that Claim 23 differentiated over prompting a user to make the recording to be convincing. This last point was emphasized by noting the lack of a limitation requiring recording to be automatically performed in base Claim 23.

In response, the present amendment to Claim 23 requires the mage recording unit to include a control unit that is to respond to “the determination that a current partial image is to be recorded to automatically perform the recording.” A similar recitation is included with new means Claim 36 and new method Claim 40. To whatever extent that it is argued that column 8, lines 47-50 of Dunton teach that block 520 includes a determination that the camera is ready to make the recording, this determination is based on the camera distance from the object and camera orientation, not maintaining proper overlap of images that is done by the user as noted at col. 8, lines 24-41 of Dunton. Accordingly, the inescapable conclusion is clear that in Dunton, it is the user who determines when the recording is to be made based on sufficient partial image overlap, not block 520.

Turning to the outstanding rejection of Claims 23, 25, and 26 under 35 U.S.C. §103(a) as being unpatentable over Dunton in view of Examiner Official Notice, it is again noted that the rejection appears to be based upon a misunderstanding of the teachings of Dunton and the subject matter of base independent Claim 23. The paragraph bridging pages 3 and 4 of the outstanding Action refers to the Claim 23 requirement for an overlapping amount calculating unit that will calculate an amount of overlap between the partial images picked up by the first image pickup unit in the abstract and not as fully set forth by Claim 23. In this regard, Claim 23 further requires that the calculation of the amount of overlap between the partial images picked up by the first image pickup unit must be “based upon the image picked up by said second image pickup unit.”

As noted at the discussion discussed above, the referenced portions of Dunton (col. 5, lines 2-6 and col. 8, lines 25-32) do not reasonably teach calculating the amount of overlap between the partial images picked up by the first image pickup unit, much less performing this calculation “based upon the image picked up” by any pickup unit. This is because the teaching of col.5, lines 2-6, simply suggests that there has to be “a sufficient amount of

subject matter overlap 150,” not any calculation to achieve it. Further, the Dunton teaching at col. 8, lines 25-32, involves no indication of a calculation of an amount of overlap between partial images being picked up by any image pickup unit as it simply suggests prompting the user to record partial image based upon the movement of the image pickup directly detected by tracking movement of a selected point in the camera’s field of view from one edge thereof to another.

Moreover, even if the block 520 teaching at col. 8, lines 42-50 is considered, these teachings simply require a distance sensor that will sense camera distance from the subject and orientation sensors to sense camera orientation prior to permitting a recording. Sensing either camera distance from the subject or camera orientation relative to the subject are not seen to require any calculations for determining overlap. Block 512 leaves no doubt that camera orientation is at least sensed and not calculated. Also, it is not this determination of proper distance and orientation that will provide automatic recording because recording is done relative to block 524 as noted at col. 8, lines 47-50 and in FIG. 5. In any event, no calculations of overlap are disclosed here and assumptions as to what might be done cannot be turned into actual reference disclosure. See *In re Warner*, 154 USPQ 173, 178 (CCPA 1967):

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

To whatever extent the tracking teachings of Dunton could be somehow interpreted as suggesting this tracking also involves some undisclosed calculation, the result still contains

no suggestion or teaching of the Claim 23 image recording determination unit that will “determine whether or not a current partial image is to be recorded based upon the amount of overlap calculated by the overlapping amount calculating unit” (emphasis added). The Dunton suggestion at col. 8, lines 25-27, is that the user is prompted to maintain needed image overlap and col. 8, lines 31-33, indicates it is the user who responds to this prompting to perform actual image recording, not a “recording determination unit,” and certainly there is no teaching or suggestion in Dunton of the Claim 23 “control unit responsive to the determination that a current partial image is to be recorded to automatically perform the recording” and similar recitals of new independent means Claim 36 or new independent method Claim 40.

Furthermore, the outstanding Action further appears to acknowledge that there is no second image pickup unit disclosed by Dunton but incorrectly suggests that the only image pickup unit present in Dunton can be reasonably said to be somehow controlling or contributing to overlap calculations of an amount of overlap.

However, and as noted above, to whatever extent that col. 5, lines 2-6, of Dunton teach that some overlap 150 is needed, they do not teach any calculation based upon any image to achieve it, nor is it taught that some particular amount of overlap is to be determined. Similarly, the tracking-monitoring of image points discussed at col. 8, lines 25-32, of Dunton involves signaling to the user that the camera has been moved to a detected position where a partial image with needed overlap can be recorded, not any calculation of some “amount of overlap” or making this calculation based upon any image. Also, it is taught that the user is prompted to record, not that an “image determination recording unit” determines whether or not a current partial image is to be recorded based upon any calculated amount of overlap and that there is a control unit, means, or step “responsive to the

determination that a current partial image is to be recorded to automatically perform the recording.”

Also, before it can be said to be obvious to substitute two cameras, each performing one of two different functions, for one camera that performs both of these functions together, it is necessary to first show that the one camera actually is performing these two different functions. This has not been done as noted above.

Moreover, the rationale is further suspect as the function of any camera is to take a picture such that the “multiple functions” being proposed for substitution with “multiple cameras conducting the functions individually” said to be “a concept that is well known and expected in the art” at page 4 of the outstanding Action is far from clear. What, exactly, are the other “functions” that were being suggested in the outstanding Action.

In any event, it is now well established that the PTO may not rely upon “official notice” to substitute unsubstantiated opinion for the principle evidence required to support a rejection. See the following from In re Ahlert, 165 USPQ 418, 421 (CCPA 1970):

Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teachings of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. The facts so noted serve to 'fill in the gaps' which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. We know of no case in which facts judicially noted comprised the principle evidence upon which a rejection was based were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used. [Emphasis added.]

Ahlert further indicates that “assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work” and “allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art must also be supported.”

Accordingly, it is believed to be clear that the outstanding Office Action improperly attempts to use “official notice” as a substitute for the required production of evidence. Not

only is this attempt not well founded under the guidelines established by Ahlert, it is further prohibited under In re Zurko, 59 USPQ2d 1693, 1698-99 (Fed. Cir. 2001), which stresses that it is improper to make an obviousness rejection without providing substantial evidence to support it as follows:

This assessment of basic knowledge . . . was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge Rather, the Board must point to some concrete evidence in the record in support of these findings. [Emphasis added, footnote and citation omitted.]

Moreover, MPEP §2144.03 requires that “official notice” is not to be used unless the “facts” so noted can be instantly and unquestionably demonstrated to be true and that when challenged by the applicant, the examiner must support the assertion with actual evidence. The undocumented assertion in the outstanding Action “that a camera that conducts multiple functions, can be substituted with multiple cameras conducting the functions individually” is “a concept that is well known and expected in the art” is challenged as vague as to what functions are being relied upon (apart from the standard picture taking function of all cameras) and the examiner is called upon to present the evidence required under Zurko and Ahlert.

In light of the above, independent Claims 23, 24, 36, 39, 40, and 43 are all believed to clearly patentably define over Dunton with or without the improperly invoked “Official Notice.” As Claims 25, 26, 37, 38, 41, and 42 all depend from one of these base independent claims, they are also believed to so define over Dunton and the improperly invoked “Official Notice.

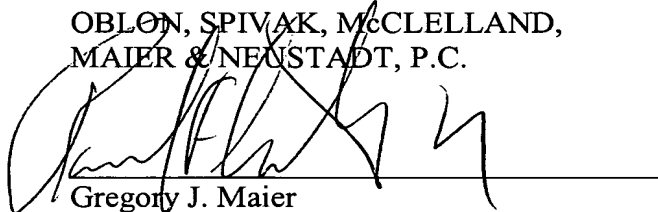
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Reply to Notice of Non-Compliant mailed 08/25/05

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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